



PATENT
Attorney Docket No. 202406

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:

Nie et al.

Group Art Unit: 1641

MAY 15 2001

Application No. 09/405,653

Examiner: K. Pham, Ph.D. TECH CENTER 1600/2900

Filed: September 24, 1999

For: WATER-SOLUBLE LUMINESCENT
QUANTUM DOTS AND
BIOMOLECULAR CONJUGATES
THEREOF AND RELATED
COMPOSITIONS AND METHODS
OF USE THEREOF

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated April 24, 2001, please consider the following remarks.

REMARKS

Summary of the Restriction Requirement

The Office sets forth a restriction requirement between Group I (claims 1-23), which is directed to a water soluble luminescent quantum dot, and classified in Class 257, subclass 40; and Group II (claims 38-39), drawn to a method of making a water soluble luminescent quantum dot, and classified in class 438, subclass 758.

Election with Traverse

Applicants hereby elect, with traverse, the claims of Group I for examination. In this regard, Applicants respectfully submit that the claims of Group II should be examined with the claims of Group I for the reasons set forth below.

Discussion of Restriction Requirement

The Office clearly fails to satisfy the requirements for a proper restriction requirement. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*” (emphasis added). As such, both of these criteria must be met for a restriction requirement to be proper. The Office has failed to establish that examination of all of the claims would constitute a serious burden on the examiner if restriction were not required. In this respect, both a search and examination of all of the claims of Groups I and II have been conducted already. Indeed, the Office Action dated September 19, 2000, entailed a substantive examination and search of claims 1-23 and 38-39 (i.e., all of the claims of Groups I and II). Accordingly, there would be no “serious burden” on the Examiner to search and examine the claims of Groups I and II together, as evidenced by the fact that such search and first examination have been done already.

Therefore, in the instant case, the restriction requirement is not proper. As such, Applicant respectfully requests the withdrawal of the restriction requirement and consideration of the claims of Group II, in addition to those of elected Group I.

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO RESTRICTION REQUIREMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: May 8, 2001 Debbie Hall